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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/430,186 | 10/29/1999 | WASAO TAKASUGI | 152-515P | 6902 |

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EXAMINER

TAYLOR, LARRY D

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/430,186

Examiner

Larry D Taylor

Applicant(s)

TAKASUGI ET AL.

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Claims 23-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8. Claims 1-22 will be prosecuted in the present application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 2, 8-11 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Regarding claim 2, the claim recites dependent upon itself (see dependency to claim 2 in line 2). The Examiner will prosecute the claim as intended to be dependent upon claim 1, however, appropriate clarification and correction is required by the Applicant.
5. Claim 8 recites the limitation "said second coil" in line 6-7. There is insufficient antecedent basis for this limitation in the claim. This indefinite limitation "second coil" also applies to: Claim 9, line 6; Claim 10, line 4; and Claim 11, line 6.

In addition, claim 11 recites the limitation "a third coil" in line 4, however there is a lack of antecedent basis for evidence of a "second coil".

6. Claim 19 recites the limitation "said booster unit" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Emori et al. (WO 9926195 A1). This art is presented to applicant in Japanese language, however European Patent EP 1031939 A1 granted to Emori et al. provides an English translation to the above mentioned patent, and thus will be physically referenced to in the rejection below.

Emori (EP translation) teaches a non-contact card 1 comprising: a booster unit having a first coil 4 and capacitor 15 capable of communicating with an external apparatus 100; and an IC element 6 on a module 2 capable of communicating with the booster unit in a wireless communication via a second coil 8 connected to the element (see figure 2). The second coil 8 is

bonded to the IC element by an adhesive resin (page 8, lines 33-35). The element has its own memory. The booster unit is provided as such the first coil is combined with the capacitor in a parallel-resonant fashion, but may also be set in a series-resonant fashion (page 7, lines 3-8). The first and second coils are arranged such that a magnetic flux direction of the first coil is made substantially coincident with a magnetic flux direction of the second. Figure 3B shows that the first coil is arranged on one surface of supporting member 5, while the second coil is supported on another surface opposite the first coil. The figure also shows that the second coil is arranged inside of the first coil. A third coil 3 may be contained in the booster unit for receiving an induction current produced in the first coil and electromagnetically coupling to the second coil. As evidenced, the booster unit has a first communication distance capable of wirelessly communicating with the external device 100, while the second coil connected to the element constitutes a second communication distance shorter than the first communication distance, the second coil capable of communicating with the booster unit. The module comprises a board 9 used to mount the element and the second coil. The first coil may consist of ferromagnetic material. A molded substrate member 11 having a predetermined shape is used to protect the module, the member containing resin. Board 9 may be constructed of an adequately strong material, possibly lead (page 8, lines 30-50). The art of Emori provide these teachings both as a product (or rather, a card) and as a process of creating the product.


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Inoue (US 5,436,441), Tanaka et al. (US 6,126,077), Kohama et al. (US 5,856,662), and Roberts et al. (US 6,152,373).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D Taylor whose telephone number is (703) 306-5867. The examiner can normally be reached on M-F (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703)-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-746-4784 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Larry D Taylor
September 30, 2002



MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800